

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* MIN-JAE HAN

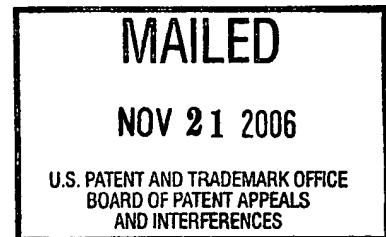
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Appeal No. 2006-2113  
Application No. 09/319,093  
Technology Center 3600

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ON BRIEF

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Before FRANKFORT, HORNER and FETTING, *Administrative Patent Judges*.  
HORNER, *Administrative Patent Judge*.

**DECISION ON APPEAL**

This is a decision on appeal under 35 U.S.C. § 134(a) from the examiner's final rejection of claims 1-18, all of the claims pending in the application. Claims 19-45 have been canceled.

We reverse.

## BACKGROUND

The appellant's invention relates to a record/playback apparatus and method. Claims 1 and 11 are representative of the subject matter on appeal, and a copy of these claims can be found in the appendix to the appellant's brief.

The examiner relies upon the following as evidence of unpatentability:

Freeny, Jr. (Freeny)	4,528,643	Jul. 09, 1985
Yoshioka	4,964,109	Oct. 16, 1990
Endoh	5,084,790	Jan. 28, 1992
Suzuki	5,850,527	Dec. 15, 1998
Ball <i>et al.</i> (Ball)	EP 0 309 298 A2	Mar. 29, 1989

The appellant has asked us to reconsider the examiner's rejection of claims 1-18 under 35 U.S.C. § 103(a) as being unpatentable over Ball in view of Suzuki, Yoshioka, Freeny and Endoh.

Rather than reiterate in detail the conflicting viewpoints advanced by the examiner and the appellant regarding this appeal, we make reference to the final office action (mailed January 11, 2005), the examiner's answer (mailed January 17, 2006) for the examiner's complete reasoning in support of the rejection and to the appellant's brief (filed December 12, 2005) and reply brief (filed March 21, 2006) for the appellant's arguments.

## OPINION

In reaching our decision in this appeal, we have carefully considered the appellant's specification and claims, the applied prior art, and the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations that follow. It is our view that, after

consideration of the record before us, the examiner has failed to set forth a prima facie case of obviousness.

In rejecting claims under 35 U.S.C. § 103(a), the examiner bears the initial burden of establishing a prima facie case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). *See also In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). The examiner can satisfy this burden by showing that some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references such that they would teach or suggest the claimed subject matter. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). It is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. *See id.* at 1073, 5 USPQ2d at 1598. In so doing, the examiner is expected to make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966). The examiner must articulate reasons for the examiner's decision. *In re Lee*, 277 F.3d 1338, 1342, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002). In particular, the examiner must show that there is a teaching, motivation, or suggestion to combine references relied on as evidence of obviousness. *Id.* at 1343, 61 USPQ2d at 1433. These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. *See Oetiker*, 977 F.2d at 1445, 24 USPQ2d at 1444. Only if this initial burden is met does the burden of coming forward with evidence or argument shift to the appellant. *Id.* at 1445, 24 USPQ2d at 1444. *See also Piasecki*, 745 F.2d at 1472, 223 USPQ at 788. Obviousness is then determined on the basis of the evidence as a

whole and the relative persuasiveness of the arguments. *See Oetiker*, 977 F.2d at 1445, 24 USPQ2d at 1444; *Piasecki*, 745 F.2d at 1472, 223 USPQ at 788.

In the rejection of independent claim 1, the examiner determined that Ball discloses a record/playback apparatus as claimed except that it fails to disclose that payment is imposed upon the user based upon dubbing speed selected by the user and causing the record/playback unit to start the recording at a standard dubbing speed without transmitting the basic data to the payment imposing unit (Answer, p. 3). The examiner relies on Suzuki for the teaching of an information providing apparatus that enables user-selected information to be recorded and enables the user to select a speed at which the information is transmitted and recorded to a local terminal, wherein payment is imposed on the user based on the selected transmission or recording speed (Answer, pp. 3-4). The examiner relies on Yoshioka for the teaching of a digital disc reproduction system that includes a control unit to control the recording operation in fast speed dubbing mode as well as standard speed dubbing mode using a selector switch (Answer, p. 4). The examiner asserts, “Yoshioka also teaches that the recording is started in the standard speed dubbing mode without transmitting any data to a payment imposing unit since Yoshioka is not concerned with paying for the service” (Answer, p. 4). The examiner finds:

Thus, it would have been obvious to one having ordinary skill in the art to implement either scenario (payment required or no payment required) in the system of Ball in view of the teachings of Susuki [*sic*] and Yoshioka. *If one was concerned about receiving payment for the dubbing service at increased speeds*, then, it would have been obvious to one having ordinary skill in the art to

modify Ball and adopt the teachings of Susuki [sic] to allow for charging based upon the dubbing speed. *If one was not concerned about receiving payment or offering the service for free if the standard dubbing speed is used,* then, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify Ball and adopt the teachings of Yoshioka to allow for recording at a standard speed without transmitting data to a payment imposing unit, thereby, starting the recording without charging the user (Answer, pp. 4-5) (emphasis added).

It is clear from the language shown in italics above that the examiner's reasoning was based on hindsight using the present invention as a roadmap by which to piece together the teachings of the prior art. None of this prior art relied upon by the examiner would have taught, suggested, or motivated one skilled in the art at the time of the invention to dub a copy at standard speed without charging for it, while at the same time charging for copies dubbed at higher than standard speeds. Both Ball and Suzuki describe systems that assess some charge for each copy made or program provided regardless of speed, because they are designed to pay a royalty to the copyright holder for every copy. For example, the system of Ball is designed to enable a customer to enter a store equipped with a kiosk-type device and make a customized cassette tape of the user's selected songs (Ball, p. 2, lines 54-57). The kiosk charges the customer for the customized product, and the system calculates royalty payments. (Ball, p. 2, lines 57-58). The information providing apparatus described in Suzuki similarly charges the customer for each program provided. Suzuki teaches varying a compression service fee (S1), which is charged in the case where a compressed program is provided, but it also teaches

charging in addition a basic fee (B1) for the program based on the popularity of the program regardless of whether it is compressed or not (Suzuki, col. 13, lines 28-36 and Figure 13).

Yoshioka, on the other hand, describes a fast speed reproduction system for digital discs in which the user is not charged at all for copies made, regardless of dubbing speed. While Yoshioka clearly teaches enabling a user to dub at standard speed or at a faster speed (col. 5, lines 16-20), Yoshioka does not mention a payment imposing unit or assess a charge to the user for dubbing. As such, Yoshioka naturally does not send information to a payment imposing unit if the user selects to copy at standard speed. However, we hold that the lack of teaching in Yoshioka of a payment imposing unit would not have led one of ordinary skill in the art at the time the invention was made to selectively charge for dubbing at higher than standard speed, while in the same system, not charge for dubbing at standard speed.

The remaining Freeny and Endoh references are relied on by the examiner to show using an owner code to identify the owner of information to be recorded and reading copyright holder ID data from a control data storage region of the recording medium. We find that neither Freeny nor Endoh cure the deficiencies of Ball, Suzuki, or Yoshioka. Specifically, neither Freeny nor Endoh disclose a system that sends certain data to a payment imposing unit to assess a payment when the user selects a dubbing speed higher than a standard speed, and that does not send such data to the payment imposing unit or assess a payment when the user selects a standard speed for dubbing. With regard to remaining rejected dependent claims 2-18, because these claim rejections rely upon the underlying rejection of independent

claim 1, the examiner's rejection of these claims also fails. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) (If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim dependent therefrom is nonobvious).

Accordingly, we do not sustain the examiner's rejection of claims 1-18 under 35 U.S.C. § 103(a) as being unpatentable over Ball in view of Suzuki, Yoshioka, Freeny, and Endoh.

To summarize, the decision of the examiner to reject claims 1-18 is reversed.

*REVERSED*

  
ANTON W. FETTING  
Administrative Patent Judge

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